

RESPONSE TO OFFICE ACTION

A. Status of the Claims and Specification

The Specification has been amended in light of the drawing and claim amendments. No new matter was introduced. Claims 111-156 were pending. Claims 1 through 118 and 163 have been canceled and claims 119-156 have been withdrawn. Claims 157-162 have been amended. Claims 164-174 have been added. Therefore, claims 157-162 and 164-174 will be pending upon entry of these amendments.

B. Drawing Objections

Figs. 6-8, 16, and 30 stand objected to under 37 C.F.R. § 1.84 (b) for not having sufficient quality to be reproducible in a printed patent. Further, the figures stand objected to under 37 C.F.R. § 1.83 (a) for allegedly not showing every feature of the invention specified in the claims. Original Figs. 6, 7A, 7B, 8A and 8B have now been canceled. Original Figs. 9 through 14A have been re-numbered as new Figs. 6 to 12 respectively. Original Figs. 15 and 16 have been amended and substituted with new Figs. 13 and 14 which have been corrected in response to the Office's objections. Figs. 24 through 29 have been re-numbered as new Figs. 15 through 20 respectively. Original Fig. 30 has been canceled and replaced with new Fig. 21 corrected in response to the Office's objections. Finally, new Figs. 22 and 23 have been added corresponding to the description on original page 43 in order to show the hinged side wall panels and the glass facades of the claims in response to the Examiner's objection that "the drawings must show every feature of the invention specified in the claims."

It is also submitted that the "checkerboard configuration" as claimed in original claim 118 and new claim 168 was shown in original Figs. 15. However, new Fig. 13, corresponding to original Fig. 15 has been amended to introduce reference numerals, and the corresponding description on pages 16 and 17 has been amended to refer to Fig. 13 (original Fig. 15) which illustrates the checkerboard configuration of new claim 168.

New Fig. 22 has been added to illustrate the claimed hinged connections described, for example, on page 15, lines 28 to 29 of the Specification. New Fig. 23 has been added to

illustrate the glass facades of claims 162 and 170 and described, for example, on page 18, lines 19-21 or on page 43, lines 12-14 of the Specification.

It is respectfully submitted that the features in the amended claims are now shown and identified in the drawings, and further that no new matter has been entered by the amendments to the drawings and the Specification. The removal of the objections to the drawings is respectfully requested.

C. Section 112 Rejections

Claims 111-118 and 157-163 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

Claims 111-118 and 163 have been canceled, rendering the rejection moot.

Claims 157 through 162 have been amended as suggested by the Office. Further newly added claims 164-174 have been reviewed in light of the requirements set by the statute. Applicant submits that each of the § 112 rejections has been attended to in the amended claims. Removal of the § 112 rejection is respectfully requested.

D. Section 102 Rejections

Claims 111-116, 157-158, and 162 and 163 stand rejected under 35 U.S.C § 102(b) as being anticipated by U.S. Patent No. 4,599,829 to DiMaritino, Sr. Further, claims 111-118 and 157-163 stand rejected under 35 U.S.C § 102(b) as being anticipated by U.S. Patent No. 6,109,189 to Tarver. In light of the above amendments and the following discussion, Applicants respectfully traverse the rejection.

The subject matter of amended claim 157 is directed to a transportable and stackable modular building unit comprising a floor panel, side wall panels and a ceiling or roof panel arranged and dimensioned to form a shipping container transportable by a containerised shipping network, and wherein at least one of the panels of the modular building unit is a movable panel removably or hingedly connected to the other panels and movable to create additional building space adjacent the space formed by the other panels of said modular building unit.

The movable panel may be a removable panel as described in the Specification and illustrated in new Fig. 14 corresponding to original Fig. 16, and as claimed in claim 158 which recites that the removable panel is “utilizable as a structural end wall, a verandah section, a roof section or a floor section to at least partly enclose said additional building space.” In an alternative embodiment described in the original description and now illustrated in new Fig. 22, the at least one movable panel is a side wall panel hingedly connected either to the base of the unit so that it can swing downwardly to form an external floor of said additional building space as claimed in amended claim 159, or hingedly connected to the top of the unit so that it can swing upwardly to form an external roof of said additional building space as claimed in amended claim 160.

New claim 164 is directed to a multi-storied building comprising a plurality of transportable and stackable modular building units, wherein at least one building unit in an upper story of the building is stacked on at least one of the building units in the story below. A further creation of additional building space or “free space” may be achieved by arranging first and second modular building units on at least one story of the building with a free space between said building units, and a further building unit stacked on said first and second building units so that the floor panel of said further building unit forms a ceiling of the free space between said first and second building units, as claimed in new claim 167. New claim 168 claims a plurality of the modular units on a plurality of levels being stacked in a checkerboard configuration with free spaces between adjacent units on each level.

US 4,599,829 (Di Martino) relates to a modular container building system which is intended for building a prison or correctional facility in which most of the container units 11 are self-contained inmate cells which are stackable one on top of another. Figure 9 shows a container unit 14 which has open sides to form a hallway or space extension unit. However, there is no disclosure or suggestion in Di Martino that either the inmate cell units 11 or the hallway unit 14 may be provided with a movable panel removably or hingedly connected to the other panels and movable to create additional building space adjacent the space formed by the other panels of the modular building unit as claimed in amended claim 157. As such, it is respectfully submitted that amended claim 157 is not anticipated by Di Martino.

Further, Di Martino does not disclose or suggest that any of the panels of the modular units 11 and 14 could be removable and utilizable as a structural end wall, a verandah section, a roof section or a floor section to at least partly enclose the additional building space created by removal of the movable panel as claimed in claim 158.

Moreover, Di Martino does not disclose or suggest that any of the panels of the building units 11 and 14 could be a side wall panel hingedly connected to the base or the top of the unit so that the side wall panel can swing downwardly or upwardly to form an external floor or roof of the additional building space created by movement of the hinged side wall panel as claimed in new claims 159 to 161. It is therefore submitted that dependent claims 158 through 161 are not anticipated by Di Martino.

Similar comments apply to independent claim 164. Further, Di Martino does not disclose a multi-storied building in which first and second modular building units on at least one story of the building are arranged with a free space between the building units, with a further building unit stacked on the first and second building units above said free space so that the floor panel of said further building unit forms a ceiling of the free space between said first and second building units as claimed in claim 157. Neither does Di Martino disclose such a multi-storied building in which a plurality of the modular units on a plurality of levels are stacked in a checkerboard configuration as claimed in new claim 168. It is therefore submitted that neither independent claim 164, nor any of the dependent claims thereon, are anticipated by Di Martino.

Furthermore, it is respectfully submitted that the subject matter of each of the independent claims is not obvious in view of Di Martino. It is submitted that Di Martino teaches away from the claimed subject matter in that an additional container unit 14 in the form of a hallway or space expansion unit is provided when a space is required between the cell unit 111 of the correctional facility. Further, there is no motivation for Di Martino to provide movable panels in the form of removable or hingedly connected side wall panels in the prison cell units 111 because it is a requirement for prison cell units to be secure so that the inmates do not escape, and also prisoners in a correctional facility do not require the creation of additional building space or free space in living quarters, unlike a residential or commercial office environment.

It is therefore submitted that it would not be obvious to modify the modular container units of Di Martino, which are solely intended for building a correctional facility, to include

removable or hingedly connected side wall panels which are movable to create additional building space as claimed in amended claim 157.

US 6,109,189 (Tarver) discloses a modular living quarters formed from a transportable modular building unit which includes hingedly mounted furniture components. The Examiner has stated that, in Tarver, "at least one wall is hinged to swing downwardly or upwardly." It is, however, respectfully submitted that the Examiner is mistaken because Tarver only discloses hinged internal furniture items such as a hinged lavatory unit 6 (column 6, lines 27-49), fold-out sofas which are convertible to a single bed (column 8, line 55 to column 9 line 67), and a table which has support members pivotally connected to the ceiling of the unit (column 10, line 5 to column 11 line 22). Thus, there is no disclosure or suggestion in Tarver of a transportable and stackable modular building unit in which at least one of the panels is a movable panel removably or hingedly connected to the other panels and movable to create additional building space adjacent the space formed by the other panels of the modular building unit, and so it is respectfully submitted that amended claim 157 is not anticipated by Tarver.

It is further submitted that Tarver also teaches away from the relevant claimed subject matter in that Tarver discloses a modular living quarters configured for maximum comfort and spaciousness, with a relatively small footprint, in which the efficiency of the layout is enhanced by having internal hinged or fold-out furniture or fittings. In contrast, amended claim 157 is directed to a modular building unit having panels arranged to form a shipping container and in which additional building space is created by providing a movable panel removably or hingedly connected to the other panels which is movable to create the additional building space adjacent the space formed by the other panels of the modular building unit. There is no suggestion or motivation to modify the modular living quarters of Tarver in this way.

It is therefore submitted that independent claim 157 and the other amended claims are not only novel, but are also not obvious in view of Tarver.

In view of the foregoing, it is respectfully submitted that all of the amended claims of this application are patentably distinct over the references. Applicant respectfully request the removal of the § 102 rejection.

PETITION FOR EXTENSION OF TIME

Pursuant to 37 C.F.R. § 1.136(a), Applicant petition for an extension of time of three-month up to and including September 29, 2004, in which to respond to the outstanding Action. A check in payment of the small entity petition fee for a three-month extension of time (\$475.00) is enclosed. Should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included, the Commissioner is authorized to deduct or credit the appropriate fees to or from Fulbright & Jaworski Deposit Account No. 50-1212/HACK:016US/MTG.

CONCLUSION

Applicants believe that the foregoing remarks fully respond to all outstanding matters for this application. Applicants respectfully request that the rejections of all claims be withdrawn so the claims may swiftly pass to issuance.

Should the Examiner desire to sustain any of the rejections discussed in relation to this Response, the courtesy of a telephonic conference between the Examiner, the Examiner's supervisor, and the undersigned attorney at 512-536-3031 is respectfully requested in advance.

Respectfully submitted,

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